

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Michael K. Blackwell, et al.
Serial No: 09/870,418
Confirmation No: 8017
Filed: May 30, 2001
For: A METHOD AND APPARATUS FOR AUTHORIZING AND
PLAYING BACK LIGHTING SEQUENCES

Examiner: Sean P. Shechtman
Art Unit: 2125

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FROM REQUIREMENT FOR RESTRICTION PURSUANT TO 37 C.F.R.
§§1.144 and 1.181(a)(2)

Sir:

In response to the Office Action mailed February 23, 2006 (copy attached) in the above-identified application, in which a Restriction Requirement was made final, Applicants respectfully petition to reconsider and withdraw the Restriction Requirement, pursuant to 37 C.F.R. §§1.144 and 1.181(a)(2). Pursuant to 37 C.F.R. §1.144, this Petition is timely, as it is being filed after a final requirement for restriction and not later than appeal.

Applicants do not believe that any fee is required for consideration of this Petition. If however a fee is required, authorization is hereby given to charge Deposit Account No. 23/2825.

Statement of Facts Involved and Points to be Reviewed Pursuant to 37 C.F.R. §1.181(b)

The original Restriction Requirement in the above-identified application was made in an Office Action mailed November 1, 2005 (copy attached). Applicants responded to the Restriction Requirement in a paper mailed November 22, 2005 (copy attached) in which an election was made and reconsideration of the Restriction Requirement by the Examiner was requested by the Applicants. In support of the request for reconsideration, Applicants distinctly and specifically pointed out in their November 22, 2005 response what are respectfully believed to be errors in the Restriction Requirement, as discussed in detail below. Accordingly, pursuant to 37 C.F.R. §1.144, 37 C.F.R. §1.181(c) and MPEP §818.03(c), Applicants thereby preserved their right to file this petition from the Restriction Requirement.

Following is a detailed statement of the facts involved and points to be reviewed for consideration of this Petition.

In response to the Office Action mailed November 1, 2005 in which a Restriction Requirement was made, Applicants elected the invention of Group I, namely claims 1, 2, 5, 6, 8-29, 30, 33, 35-38, 42, 43, and 45-61, for further prosecution. Within Group I, Applicants elected Species A, on which claims 8, 11-13, 45-50 and 57 are believed to read. The election of Group I and Species A was made with traverse to the Restriction Requirement. The Applicants respectfully submitted that search and examination of all of the claims pending in the application could be made without serious burden on the Examiner. Specifically, Applicants submitted that the overall subject matter covered by the claims essentially had not changed from the claims as originally filed, and that these claims had been examined substantively by the Examiner in the Office Action dated February 9, 2005 (copy attached).

Following the Applicants' request for reconsideration in their Response dated November 22, 2005, another Office Action was mailed on February 23, 2006 in which the Examiner acknowledged and responded to the assertions in the Applicants' Response dated November 22, 2005. The Office Action stated that Applicants' request for reconsideration was not found persuasive because "the amendment filed August 11th 2005 completely changed the scope of the claims and/or added new limitations."

Applicants respectfully disagree, and submit that the requirement for restriction is improper and should be withdrawn for the reasons addressed below.

I. The restriction of Group II is not proper.

The restriction of Group II is not proper, because the subject matter of these claims has already been searched and examined.

Group II includes three independent claims – claim 4, claim 32, and claim 41. As shown in the tables below:

- Each limitation of claim 4 as restricted has been previously searched and examined.
- Claim 32 as restricted corresponds to claim 32 as originally examined, rewritten in independent form, and therefore has been previously searched and examined.
- Claim 41 as restricted corresponds to claim 41 as originally examined, rewritten in independent form and amended to correct an antecedent basis issue, and therefore has been previously searched and examined.

a. Independent Claim 4

Claim 4	Relation to Previously Examined Subject Matter
A method for executing a lighting program to control a plurality of lights, the lighting program defining a plurality of states for the plurality of lights, the method comprising acts of:	Identical to preamble of claim 1 as originally examined.
(A) transferring the lighting program from a first device on which the lighting program was created to at least one computer readable medium, the lighting program being transferred in a data format that represents a final data stream capable of directly controlling the plurality of lights;	Identical to clause (A) of claim 1 as originally examined.
(B) coupling the computer readable medium to a second device;	Identical to clause (B) of claim 1 as originally examined.
(C) coupling the second device to the plurality of lights; and	Identical to clause (C) of claim 1 as originally examined.

(D) executing the lighting program on the second device by reading the final data stream from the computer readable medium and...	Appears identically in clause (D) of claim 1 as originally examined.
....transferring the final data stream directly to the plurality of lights without interpolating any of the data included therein to determine a state for the plurality of lights...	Appears identically in claim 4 as originally examined, which depended from claim 1 as originally examined.
...so as to control the plurality of lights.	Appears identically in clause (D) of claim 1 as originally examined.

Thus, each limitation of claim 4 as restricted has been previously searched and examined.

b. Independent Claim 32

Claim 32	Relation to Previously Examined Subject Matter
A computer readable medium encoded with a lighting program that, when executed, controls a plurality of lights and defines a plurality of states for the plurality of lights, the lighting program being encoded in a data format that represents a final data stream capable of directly controlling the plurality of lights...	Appears identically in claim 30 as originally examined.
...wherein the lighting program is encoded in a data format without any information necessary to interpolate any of the data included therein to determine a state for the plurality of lights.	Appears identically in claim 32 as originally examined, which depended from claim 30 as originally examined.

Thus, claim 32 as restricted corresponds to claim 32 as originally examined, rewritten in independent form, and therefore has been previously searched and examined.

c. Independent Claim 41

Claim 41	Relation to Previously Examined Subject Matter
An apparatus for executing a lighting program to control a plurality of lights, the lighting program defining a plurality of states for the plurality of lights, the apparatus comprising:	Identical to preamble of claim 37 as originally examined.
at least one storage medium to store the lighting program in a data format that represents a final data stream capable of directly controlling the plurality of lights; and	Identical to first clause of claim 37 as originally examined.

at least one controller that executes the lighting program by reading the final data stream... ...from the at least one storage medium...	Appears identically in the second clause of claim 37 as originally examined. The second clause of claim 37 as originally examined recited “from the computer readable medium,” which lacked antecedent basis. Accordingly, claim 41 corrected this by reciting “from the at least one storage medium.”
...and passing the final data stream to the plurality of lights to control the plurality of lights,...	Appears identically in the second clause of claim 37 as originally examined.
...wherein the at least one controller transfers the final data stream directly to the plurality of lights without interpolating any of the data included therein to determine one of the plurality of states for the plurality of lights.	Appears identically in claim 41 as originally examined, which depended from claim 37 as originally examined.

Thus, claim 41 as restricted corresponds to claim 41 as originally examined, rewritten in independent form and amended to correct an antecedent basis issue, and therefore has been previously searched and examined.

Accordingly, the subject matter of each of independent claims 4, 32, and 41 has already been searched and examined; hence the Examiner already has demonstrated that examination of these claims can be made without serious burden. According to MPEP §803, “if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits” (emphasis added). For at least this reason, the restriction of Group II is not proper and should be withdrawn.

II. The restrictions of Groups III, IV and V, relative to each other, are not proper.

Claims 63 and 65 (Group III), claims 64 and 66 (Group IV), and claim 67¹ (Group V) were separately restricted. Applicants respectfully submit that this is improper. First, claims 63-67 as originally filed were examined together in the Office Action dated February 9, 2005. Thus, the Examiner has already demonstrated that these claims can be examined together without serious burden. Second, only one recitation, i.e., “from an external device,” has been added to each of independent claims 63-67 relative to the respective claims as originally filed. This *same* recitation has been added to each of claims 63-67. Although the Examiner alleges that each of

¹ Erroneously identified as claim 65 in the Office Action dated November 1, 2005.

Groups III, IV, and V is classified under a different subclass within class 700, these classifications are independent of the added recitation. That is, the added language did not compel the classification of these claims in different subclasses.

In view of the foregoing, separate restriction of Groups III, IV, and V is improper, and hence the claims of Groups III, IV, and V should be examined together.

III. The restrictions of Groups III, IV and V, relative to Group I, are not proper.

In addition, Applicants respectfully submit the restrictions of Groups III, IV, and V, *relative to Group I*, are improper, because the subject matter of these claims (including the added language “from an external device”) is presently being searched and examined in connection with the elected claims.² Specifically, the Examiner identified Group I as allegedly including three species, namely:

Species A – input from an external device

Species B – input from a user

Species C – input from a sensor

Applicants elected Group I, Species A for further prosecution. As discussed below, it is noteworthy that each of claims 63-67 recites “input from an external device,” i.e., the particular feature corresponding precisely to the elected species.

Groups III, IV and V include five independent claims – claims 63, 64, 65, 66 and 67. As shown in the tables below:

- The subject matter of claim 63 is already being examined as part of claim 12 and claim 1 (from which claim 12 depends).
- The subject matter of claim 64 is already being examined as part of claim 13 and claim 1 (from which claim 13 depends).

² The outstanding Office Action dated February 23, 2006 addresses claims 1, 2, 5, 6, 8, 11-13, 17-20, 30, 33, 36, 37, 42, 45-50, 54, 55, 57, 60 and 61.

- The subject matter of claim 65 is already being examined as part of claim 46 and claim 37 (from which claim 46 depends).
- The subject matter of claim 66 is already being examined as part of claim 50 and claim 37 (from which claim 50 depends).
- The subject matter of claim 67 is already being examined as part of claim 61, claim 57 (from which claim 61 depends), and claim 37 (from which claim 57 depends).

a. Independent Claim 63

Claim 63	Relation to Presently Examined Subject Matter
A method for executing a lighting program to control a plurality of lights, the lighting program including a sequence of commands for controlling the plurality of lights, the method comprising acts of:	Closely mirrors language in preamble of claim 1, presently being examined.
(A) executing the lighting program on a second device by reading the lighting program from a computer readable medium and passing the sequence of commands to the plurality of lights to control the plurality of lights; and	Closely mirrors language in clause (D) of claim 1.
(B) during execution of the lighting program in act (A), changing a parameter of at least one effect assigned, in the lighting program, to at least one of the plurality of lights from a programmed parameter to a new parameter in response to an input from an external device received at the second device.	Closely mirrors language of claim 12 (which depends from claim 1), presently being examined.

Thus, the subject matter of claim 63 as restricted is already being examined; namely, as part of claim 12 and claim 1 (from which claim 12 depends). Although claim 63 is broader than claim 12, the subject matter of claim 63 is completely subsumed within claim 12. Therefore, the Examiner is already searching and examining the subject matter of claim 63 as part of the elected claims.

b. Independent Claim 64

Claim 64	Relation to Presently Examined Subject Matter
A method for executing a lighting program to control a plurality of lights, the lighting program including a sequence of commands for controlling the plurality of lights, the method comprising acts of:	Closely mirrors language in preamble of claim 1, presently being examined.
(A) executing the lighting program on a second device by reading the lighting program from a computer readable medium and passing the sequence of commands to the plurality of lights to control the plurality of lights; and	Closely mirrors language in clause (D) of claim 1.
(B) during execution of the lighting program in act (A), changing a speed at which the lighting program is executed from a programmed speed to a new speed in response to an input from an external device received at the second device.	Closely mirrors language of claim 13 (which depends from claim 1), presently being examined.

Thus, the subject matter of claim 64 as restricted is already being examined; namely, as part of claim 13 and claim 1 (from which claim 13 depends). Although claim 64 is broader than claim 13, the subject matter of claim 64 is completely subsumed within claim 13. Therefore, the Examiner is already searching and examining the subject matter of claim 64 as part of the elected claims.

c. Independent Claim 65

Claim 65	Relation to Presently Examined Subject Matter
An apparatus for executing a lighting program to control a plurality of lights, the lighting program including a sequence of commands for controlling the plurality of lights, the apparatus comprising:	Closely mirrors language in preamble of claim 37, presently being examined.
at least one storage medium to store the lighting program;	Language appears in first clause of claim 37.
at least one input from an external device to receive information concerning an external environment; and	Closely mirrors language of claim 46 (which depends from claim 37), presently being examined.
at least one controller that executes the lighting program by reading the lighting program from the at least one storage medium and passing the sequence of commands to the plurality of lights to control the plurality of lights,...	Closely mirrors language in second clause of claim 37.

...wherein, during execution of the lighting program, the controller changes a parameter of at least one effect assigned, in the lighting program, to at least one of the plurality of lights from a programmed parameter to a new parameter in response to the received information.	Closely mirrors language of claim 46.
---	---------------------------------------

Thus, the subject matter of claim 65 as restricted is already being examined; namely, as part of claim 46 and claim 37 (from which claim 46 depends). Although claim 65 is broader than claim 46, the subject matter of claim 65 is completely subsumed within claim 46. Therefore, the Examiner is already searching and examining the subject matter of claim 65 as part of the elected claims.

d. Independent Claim 66

Claim 66	Relation to Presently Examined Subject Matter
An apparatus for executing a lighting program to control a plurality of lights, the lighting program including a sequence of commands for controlling the plurality of lights, the apparatus comprising:	Closely mirrors language in preamble of claim 37, presently being examined.
at least one storage medium to store the lighting program;	Language appears in first clause of claim 37.
at least one input from an external device to receive information concerning an external environment; and	Closely mirrors language of claim 50 (which depends from claim 37), presently being examined.
at least one controller that executes the lighting program by reading the lighting program from the at least one storage medium and passing the sequence of commands to the plurality of lights to control the plurality of lights,...	Closely mirrors language in second clause of claim 37.
...wherein, during execution of the lighting program, the controller changes a speed at which the lighting program is executed from a programmed speed to a new speed in response to the received information.	Language appears in claim 50.

Thus, the subject matter of claim 66 as restricted is already being examined; namely, as part of claim 50 and claim 37 (from which claim 50 depends). Although claim 66 is broader than claim 50, the subject matter of claim 66 is completely subsumed within claim 50.

Therefore, the Examiner is already searching and examining the subject matter of claim 66 as part of the elected claims.

e. Independent Claim 67

Claim 67	Relation to Presently Examined Subject Matter
An apparatus for executing a lighting program to control a plurality of lights, the lighting program including a sequence of commands for controlling the plurality of lights, the apparatus comprising:	Closely mirrors language in preamble of claim 37, presently being examined.
at least one storage medium to store the lighting program;	Language appears in first clause of claim 37.
a plurality of inputs from at least one external device to receive information concerning an external environment;	Closely mirrors language of the first clause of claim 57 (which depends from claim 37) and claim 61 (which depends from claim 57), both presently being examined.
a cue table that includes a plurality of functions to interpret actions to be taken during execution of the lighting program based upon combined information received at the plurality of inputs;	Closely mirrors language of the second clause of claim 57 and claim 61.
at least one controller, coupled to the cue table, that executes the lighting program by reading the lighting program from the at least one storage medium and passing the sequence of commands to the plurality of lights to control the plurality of lights,...	Closely mirrors language in second clause of claim 37.
... wherein, during execution of the lighting program, the controller changes execution of the light program based upon information received from the cue table.	Closely mirrors language in last clause of claim 57.

Thus, the subject matter of claim 67 as restricted is already being examined; namely, as part of claim 61, claim 57 (from which claim 61 depends), and claim 37 (from which claim 57 depends). Although claim 67 is broader than claim 61, the subject matter of claim 67 is completely subsumed within claim 61. Therefore, the Examiner is already searching and examining the subject matter of claim 67 as part of the elected claims.

Accordingly, the subject matter of independent claims 63, 64, 65, 66, and 67 is presently being searched and examined; hence, the Examiner already has demonstrated that examination of these claims can be made without serious burden to the Examiner. According to MPEP §803, “if

the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits” (emphasis added). For at least this reason, the restrictions of Groups III, IV, and V, relative to Group I, are not proper and should be withdrawn.

Conclusion

Applicants have distinctly and specifically pointed out what are believed to be errors in the Restriction Requirement, and respectfully request the Commissioner to withdraw this requirement.

Favorable action is earnestly solicited.

Respectfully submitted,
Michael K. Blackwell, et al., *Applicants*

By: /Joseph Teja, Jr./
Joseph Teja, Jr., Reg. No. 45,157
Melissa A. Beede, Reg. No. 54,986
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2211
Telephone: (617) 720-3500

Attorney Docket No.: C1104.70001US00
Date: May 12, 2006